

#49
2/2/4
PATENT
Docket No.: 45751US012

AF
3761

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

JOSEPH P. KRONZER ET AL.

Serial No.: 08/661,834

Filed: June 11, 1996

For: FIBROUS FILTRATION FACE MASK

Box AF

Group Art Unit: 3761

Examiner: Aaron J. Lewis

RECEIVED
FEB 20 2004

REPLY BRIEF

CERTIFICATE OF MAILING TECHNOLOGY CENTER R3700

I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to: Mail Stop Appeal Brief – Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA on:

February 13, 2004

Date

Signed by: Esmeralda Mestizo

Dear Sir:

This is a reply to the Examiner's Answer mailed on January 14, 2004. This Brief is being filed in triplicate.

REMARKS

Appellants have two remarks in reply to the Examiner's Answer:

First, the Examiner's **Grouping of Claims** is incorrect. The correct grouping is: (1) Claims 25, 26, 27, 29 and 30; (2) Claim 32; and (3) Claims 28, 31, 33 and 35-37. The reasons for these groupings are clearly explained in the Argument section in which the patentability of each group is separately discussed. The Examiner's Answer is further improper because it ignores the argument in section B of the Argument that claims 28, 31, 33 and 35-37 are separately patentable.

Second, the Examiner has implied an incorrect legal standard for inherency. On page 10 of the Answer, the Examiner states that “one of ordinary skill would appreciate that experimental results vary from one test example to another and these two test examples do not definitively establish that surface fuzz values of greater than 7.5 cannot be obtained from Dyrud et al. ‘619 hot molding of fibrous filtration face masks having less than 85 weight percent bicomponent fiber content as illustrated by the laboratory results of lot 316B attached to the Kronzer declaration.” Thus, the Examiner is apparently arguing that, in order to show that Dyrud does not inherently possess the claimed surface fuzz values, applicants must “definitively establish that surface fuzz values of greater than 7.5 cannot be obtained from Dyrud et al. ‘619.” This is the wrong standard for determining inherency. As stated in the MPEP § 2112, “In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.” quoting *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original). The Examiner has not provided a basis in fact or technical reasoning that the claimed surface fuzz values would necessarily flow from the teachings of Dyrud et al. Thus, the Patent Office has not met its burden of establishing that the face masks of Dyrud et al. inherently possess surface fuzz values of greater than 7.5.

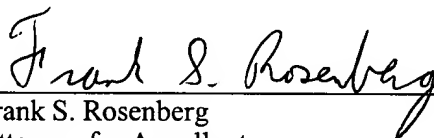
The correct standard for inherency is set forth in the quotation from *Levy*, and the correct standard for determining whether Dyrud makes obvious surface fuzz values greater than 7.5 is set forth in the *Ultradent* case that is cited in the Appeal Brief.

Conclusion

The above remarks point out two new errors in the Examiner's Answer. It should be understood that Appellant maintains all arguments from the Appeal Brief, and need not reiterate those arguments in this Reply Brief. For the reasons set forth in the Appeal Brief, appellants respectfully submit that the Examiner has erred in rejecting this application under 35 U.S.C. § 103. Please reverse the section 103 rejection of all pending claims.

Dated this 13th day of February, 2004.

Respectfully submitted,



Frank S. Rosenberg
Attorney for Appellant
Registration No. 37,068
18 Echo Hill Lane
Moraga, CA 94556
Tel. (925) 376-8416

Send correspondence to:

Office of Intellectual Property Counsel
3M Innovative Properties Company
P.O. Box 33427
St. Paul, Minnesota 55133-3427
Telephone: (651) 736-7776
Facsimile: (651) 736-3833